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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Eugene Feinberg

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EXAMINER

SAINDON, WILLIAM V

ART UNIT

PAPER NUMBER

3623

MAIL DATE

DELIVERY MODE

03/13/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/613,507	Applicant(s) FEINBERG ET AL.	
	Examiner WILLIAM V. SAINDON	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,8,11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,8,11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following NON FINAL rejection is in response to Applicant's submission received November 12, 2008. Claims 1, 11, and 12 were amended. No claims were added or canceled. Therefore, claims 1-4, 6, 8, 11, and 12 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 12, 2008 has been entered.

Response to Amendment

3. Applicant's amendments are acknowledged.

Response to Arguments

4. Applicant's arguments are acknowledged but are moot in view of the following rejections.

Claim Rejections - 35 USC § 101

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4, 6, 8, 11, and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The steps recited do not qualify as a statutory process. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

The claims are not tied to another statutory class. The steps recited either do not require a particular apparatus (e.g. a particular computer), or only mention a nominal recitation of a computer (e.g. preamble). The fact that it may be practiced on a computer is not significant since all practical uses of complex algorithms are on a computer so that they can be performed quickly. Therefore, the claims are non-statutory because the claims amount to a preemption of all uses of this algorithm.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-4, 6, 8, 11, and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The independent claims recite various functions, but the claims and specification do not provide any particular structure or method by which to perform the various functions in line with their broad scope. The examiner notes that there is support, however, for the particular embodiment described in the specification on pages 10-12 as shown in steps 1-17. However, this particular algorithm does not provide enablement for the entire scope of the broad claims.

The functions at issue are: "calculating a theoretical probability," "calculating an actual probability," "creating a potential schedule," and "searching for the feasible schedule." While the specification provides one way to perform these functions, the specification does not provide a general way that would enable all potential methods of performing these functions.

For example, the claim describes the desired result of a function: "creating a potential schedule." The claim itself does not define the structure or method of the function used to reach that result. The claimed limitation does not fall under 35 USC § 112 ¶ 6 - "means for," which would allow the scope of the claim to be defined as the particular methods or structure enumerated in the specification. Further, one of ordinary

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skill in the art would not understand the "creating" limitation to imply any particular structure or method. Therefore, the claim is properly construed to encompass any and all means for calculating an amount of rework.

The specification, however, provides only one way to create a potential schedule. See p. 14, lines 11-17, and p. 11-12, step 8.

When a limitation encompasses any and all structures or acts for performing the recited function, including those which were not what the applicant had invented, the disclosure fails to provide a scope of enablement commensurate with the scope of the claim. See Ex parte Miyazaki, Appeal No. 2007-3300, p. 27 (BPAI, 2008) (referencing Halliburton Oil Well Cementing Co. v. Walker, 329 US 1 (1946)). Because the disclosure does not enable every structure and act that reasonably falls within the claim's scope, the disclosure fails to provide an adequate scope of enablement as required by 35 USC 112, first paragraph.

8. Claims 1-4, 6, 8, 11, and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Specifically, as mentioned above, applicant demonstrates possession of only one potential embodiment of the broad claim coverage. Because one embodiment does not

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suggest the potential other forms of algorithms that fall under the claim's scope, one would not be conveyed of possession of an invention that covered such broad scope.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. **Claims 1-4, 6, 8, 11, and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Applicant deleted the "determining ... whether it is impossible to generate a feasible schedule" step. However, it appears that this step is a necessary part of the invention because the specification does not suggest that this step is optional.

Therefore, applicant is not claiming the subject matter which the applicant regards as his invention. The examiner suggests applicant re-introduce this step.

11. Examiner's Note: The examiner suggests that an interview would be beneficial for furthering prosecution of this case.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM V. SAINDON whose telephone number is (571)270-3026. The examiner can normally be reached on M-F 7:30-5; alt. Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/wvs/

/Beth V. Boswell/

Supervisory Patent Examiner, Art Unit 3623